

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 5267.01	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US00/09541	International filing date (day/month/year) 11 APRIL 2000	Priority date (day/month/year) 13 APRIL 1999
International Patent Classification (IPC) or national classification and IPC IPC(7): H04N 7/173 and US Cl.: 725/87		
Applicant DISCOVERY COMMUNICATIONS INC.		

<ol style="list-style-type: none"> <li>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</li> <li>2. This REPORT consists of a total of <u>7</u> sheets.  <div style="margin-left: 20px;"> <input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority. (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).            These annexes consist of a total of <u>2</u> sheets.         </div> </li> <li>3. This report contains indications relating to the following items:             <table style="margin-left: 20px; border: none;"> <tr> <td style="width: 20px;">I</td> <td><input checked="" type="checkbox"/></td> <td>Basis of the report</td> </tr> <tr> <td>II</td> <td><input type="checkbox"/></td> <td>Priority</td> </tr> <tr> <td>III</td> <td><input type="checkbox"/></td> <td>Non-establishment of report with regard to novelty, inventive step or industrial applicability</td> </tr> <tr> <td>IV</td> <td><input type="checkbox"/></td> <td>Lack of unity of invention</td> </tr> <tr> <td>V</td> <td><input checked="" type="checkbox"/></td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement</td> </tr> <tr> <td>VI</td> <td><input type="checkbox"/></td> <td>Certain documents cited</td> </tr> <tr> <td>VII</td> <td><input type="checkbox"/></td> <td>Certain defects in the international application</td> </tr> <tr> <td>VIII</td> <td><input checked="" type="checkbox"/></td> <td>Certain observations on the international application</td> </tr> </table> </li> </ol>	I	<input checked="" type="checkbox"/>	Basis of the report	II	<input type="checkbox"/>	Priority	III	<input type="checkbox"/>	Non-establishment of report with regard to novelty, inventive step or industrial applicability	IV	<input type="checkbox"/>	Lack of unity of invention	V	<input checked="" type="checkbox"/>	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement	VI	<input type="checkbox"/>	Certain documents cited	VII	<input type="checkbox"/>	Certain defects in the international application	VIII	<input checked="" type="checkbox"/>	Certain observations on the international application
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Date of submission of the demand  13 NOVEMBER 2000	Date of completion of this report  13 DECEMBER 2001
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231	Authorized officer  CHRISTOPHER GRANT
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## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/09541

## I. Basis of the report

1. With regard to the **elements** of the international application:\*☐ the international application as originally filed☒ the description:

pages (See Attached) \_\_\_\_\_, as originally filed  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

☒ the claims:

pages (See Attached) \_\_\_\_\_, as originally filed  
pages \_\_\_\_\_, as amended (together with any statement) under Article 19  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

☒ the drawings:

pages (See Attached) \_\_\_\_\_, as originally filed  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

☒ the sequence listing part of the description:

pages (See Attached) \_\_\_\_\_, as originally filed  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).  
☐ the language of publication of the international application (under Rule 48.3(b)).  
☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in printed form.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority in written form.  
☐ furnished subsequently to this Authority in computer readable form.  
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.  
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

- ☒ the description, pages NONE  
☒ the claims, Nos. NONE  
☒ the drawings, sheets/fig NONE

5. ☐ This report has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

\*\*Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

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**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. statement**

Novelty (N)	Claims <u>1-216</u>	YES
	Claims <u>217-220</u>	NO
Inventive Step (IS)	Claims <u>NONE</u>	YES
	Claims <u>1-220</u>	NO
Industrial Applicability (IA)	Claims <u>1-220</u>	YES
	Claims <u>NONE</u>	NO

**2. citations and explanations (Rule 70.7)**

Claims 1-216 lack an inventive step under PCT Article 33(3) as being obvious over Hendricks (WO 95/15649) and Wilson (5742680).

Considering claim 1, Hendricks discloses an apparatus that provides electronic book to a subscriber, comprising:

- a) a processor (located at 278) that communicates with an electronic book ordering site (282);
- b) a transmitter (located at 278);
- c) a receiver module (282); and
- f) a memory (600).

Although Hendricks discloses encrypting/decrypting, he fails to specifically disclose a local authorization code that allows the data signal to be decrypted for viewing as recited in the claim.

Wilson discloses a receiver (figure 1) for receiving program data and local authorization codes for decrypting programs for viewing. Encryption and corresponding decryption technique prevent unauthorized viewers from watching private or pay programs. See abstract and column 5, lines 5-40.

It would have been obvious to modify Hendricks' system to include receiving a local authorization code that allows the program to be decrypted for viewing, as taught by Wilson, for the typical advantage of enabling authorized viewers to watch private or pay programs.

Claim 2 is met by the combined systems of Hendricks and Wilson, wherein the viewer is disclosed throughout the Hendricks reference including but not limited to figures 6a and 11.

Claims 3-14 are met by the combined systems of Hendricks and Wilson, wherein the library unit is disclosed throughout the Hendricks reference including but not limited to figures 6a and 8.

(Continued on Supplemental Sheet.)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claims 59-92 are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because the claims are indefinite for the following reason(s):

In claim 59, lines 7-8 the phrase "a receiver that receives an encrypted electronic book and a local authorization code that allows the encrypted electronic book to be encrypted for viewing" implies that the encrypted electronic book is to be encrypted (again) by the local authorization code. If the electronic book is already encrypted (first encryption), then the local authorization code is not necessary for the second encryption.

## Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

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## I. BASIS OF REPORT:

This report has been drawn on the basis of the description,  
page(s) 1-74 , as originally filed.  
page(s) NONE, filed with the demand.  
and additional amendments:  
NONE

This report has been drawn on the basis of the claims,  
page(s) 75-79 and 82-96 , as originally filed.  
page(s) NONE, as amended under Article 19.  
page(s) NONE, filed with the demand.  
and additional amendments:  
Pages 80-81, filed with the letter of 12 October 2001

This report has been drawn on the basis of the drawings,  
page(s) 1-53 , as originally filed.  
page(s) NONE, filed with the demand.  
and additional amendments:  
NONE

This report has been drawn on the basis of the sequence listing part of the description:  
page(s) NONE, as originally filed.  
pages(s) NONE, filed with the demand.  
and additional amendments:  
NONE

## V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

Claims 15-49 and 51-58 are met by figures 1-18(Hendricks).

Considering claim 59, Hendricks discloses a system for distributing an electronic book from a remote site to an apparatus capable of viewing the electronic book comprising:

- a) an electronic book distribution point (250);
- b) a network (208) coupled to the distribution point;
- c) an electronic book device coupled to the network, the electronic book comprising:
- d) an electronic book viewer (266);
- e) home subsystem (258);
- f) an interface (212); and
- g) a memory (262).

Although Hendricks discloses encrypting/decrypting, he fails to specifically disclose a local authorization code that allows the encrypted electronic book to be decrypted for viewing as recited in the claim.

Wilson discloses a receiver (figure 1) for receiving program data and local authorization codes for decrypting programs for viewing. Encryption and corresponding decryption technique prevent unauthorized viewers from watching private or pay programs. See abstract and column 5, lines 5-40.

It would have been obvious to modify Hendricks' system to include receiving a local authorization code that allows any program to be decrypted for viewing, as taught by Wilson, for the typical advantage of enabling authorized viewers to watch private or pay programs.

Claims 60-67 and 70-92 are met by the combined systems of Hendricks and Wilson. See figures 2-6 (Hendricks).

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 11

Considering claim 93, Hendricks discloses an apparatus that provides electronic book ordering and distribution comprising:

- a) a terminal that displays electronic books and generates electronic book orders (266, figure 6a);
- b) an order and authorization system (330, figure 3); and
- c) a broadcaster (358, figure 3).

Although Hendricks discloses encrypting/decrypting, he fails to specifically disclose a local authorization code that allows the electronic book to be decrypted for viewing as recited in the claim.

Wilson discloses a receiver (figure 1) for receiving program data and local authorization codes for decrypting programs for viewing. Encryption and corresponding decryption technique prevent unauthorized viewers from watching private or pay programs. See abstract and column 5, lines 5-40.

It would have been obvious to modify Hendricks' system to include receiving a local authorization code that allows any program to be decrypted for viewing, as taught by Wilson, for the typical advantage of enabling authorized viewers to watch private or pay programs.

Claims 94-97 and 100-105 are met by the combined systems of Hendricks and Wilson. Note figures 14A-14J illustrated by Hendricks.

Claims 106-107 and 116 are met by the combined systems of Hendricks and Wilson. Note billing and collection system (278) (figure 2) of Hendricks.

Claims 108-115 and 117-118 are met by the combined systems of Hendricks and Wilson. Note Hendricks' systems in figures 1-6.

Considering claim 119, Hendricks discloses a system that provides broadcast electronic book ordering and delivery, comprising:

- a) a terminal (266, figure 6a or 266 figure 18a);
- b) a processor (330-334, figure 3 or 1024, figure 18a); and
- c) a delivery system (358, figure 3 or modulators 18a).

Although Hendricks discloses encrypting/decrypting, he fails to specifically disclose a local authorization code that allows the electronic book to be decrypted for viewing as recited in the claim.

Wilson discloses a receiver (figure 1) for receiving program data and local authorization codes for decrypting programs for viewing. Encryption and corresponding decryption technique prevent unauthorized viewers from watching private or pay programs. See abstract and column 5, lines 5-40.

It would have been obvious to modify Hendricks' system to include receiving a local authorization code that allows any program to be decrypted for viewing, as taught by Wilson, for the typical advantage of enabling authorized viewers to watch private or pay programs.

Claims 120-133 are met by the combined systems of Hendricks and Wilson. See Hendricks figures 14Aa-14J.

Claims 134-178, 180, 182-184, 186-207, 211-212 and 216 are met by the combined systems of Hendricks and Wilson. See figures 1-18 of Hendricks.

Considering claims 50, 68-69, 98-99, 179, 181, 185 and 208-210, the combined systems of Hendricks and Wilson disclose all the claimed subject matter above, except for the Internet Web site, the Intranet site, electronic guide provided over the Internet and one or more of number identification, user name, addresses and browser related services as recited in the claims.

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**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

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It is notoriously well known in the art that the Internet is the most widely used source of information including guide information and that an Intranet site is routinely used for sharing information within a company or organization. Note that the Internet and Intranet includes a client server system having number identification, user name, addresses and browser related services/options.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Hendricks and Wilson to include the Internet Web site, electronic guide provided over the Internet, an Intranet site and one or more of number identification, user name, addresses and browser related services because an Internet web site is the mostly widely used source of various information and an Intranet site is routinely used for sharing information within a company or organization. Furthermore interacting with the Internet/Intranet involves processing and/or manipulating number identification, user name, addresses and browser related servers/options.

Considering claims 213-215, the combined systems of Hendricks and Wilson disclose all the claimed subject matter above, except for e-mails as recited in the claims.

It is notoriously well known in the art that e-mails are routinely used to electronically transfer information between users.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Hendricks and Wilson to include e-mails for the typical advantage of utilizing a commonly used communication technique for sending and receiving information.

Claims 217-220 lack novelty under PCT Article 33(2) as being anticipated by Hendricks (W0 95/15649).

Considering claim 217, Hendricks discloses a system for delivering electronic books, comprising:

a plurality of machines (a library at each home), a machine (library) comprising:

- b) a microprocessor (628); and
- c) a transceiver (604);
- d) a memory (600);
- e) a network (coaxial or telephone network);
- f) an interface (212,270); and
- g) an electronic book viewer (figure 11).

Claims 218-220 are met by figures 1-18.

## ----- NEW CITATIONS -----

US 5,742,680 A (WILSON) 21 April 1998, abstract, column 5, lines 5-40.

US 4,855,725 A (FERNANDEZ) 08 August 1989, abstract, figures 1-3.

WO 95 15649 A (HENDRICKS et al.) 08 June 1995, whole document